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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**



In re the Application of: **Mitsuo KITAI et al.**

Serial Number: **09/897,114**

Filed: **July 3, 2001**

Group Art Unit: **3721**

Examiner: **Michelle Lopez**

PTO Confirmation No.: **9231**

For: **CHOPPER FOLDER FOR ROTARY PRESS**

Attorney Docket No.: **010797**

Customer No.: **38834**

SUBMISSION OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

June 8, 2004

Sir:

Submitted herewith are an original and two copies of an Appeal Brief in the above-identified U.S. patent application.

Attached please find a check in the amount of \$330.00 for the Appeal Brief fee.

If any additional fees are due in connection with this submission, please charge our Deposit Account No. 50-2866. This paper is filed in triplicate.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

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Attachment: Fee - \$330.00
Appeal Brief

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

APPEAL BRIEF FOR THE APPLICANTS

Mitsuo KITAI et al.

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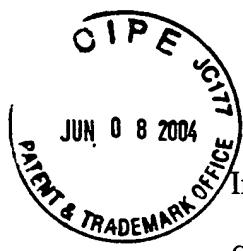
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Date: June 8, 2004
Attorney Docket No.: 010797



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JUN 08 2004

In re the Application of: **Mitsuo KITAI et al.**

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BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

June 8, 2004

Sir:

Following the filing of the Notice of Appeal on April 15, 2004, the following is the Applicants' Appeal Brief.

I. REAL PARTY IN INTEREST

The real party in interest is TOKYO KIKAI SEISAKUSHO, LTD, with a mailing address of 26-24, SHIBA 5-CHOME, MINATO-KU, TOKYO, JAPAN.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

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III. STATUS OF CLAIMS

Pending claim 1 is finally rejected by the Office Action dated December 15, 2003.

Claim 2 is allowed.

IV. STATUS OF AMENDMENTS

The Applicants appeal the final rejection of the Office Action mailed on December 15, 2003. No amendments were made in the response after final, filed March 15, 2004.

V. SUMMARY OF INVENTION

The invention can be understood by relating the recited claimed language with the drawings and explanations in the specification. A citation provided hereinbelow merely indicates by way of an example a place of support in the specification. There may be other places of support in the specification. The indicated example should not be construed as the metes and bounds of the claim. The metes and bounds of the claim should only be construed by the invention as disclosed in the patent application as a whole.

Claim 1: A chopper folder for a rotary press for folding signatures which are periodically conveyed, one signature at a time, from a folding machine, comprising:
a pair of folding rollers 4 for folding a signature 1 parallel to a conveyance direction of said signatures;
a prime mover 7;

a crank arm 15 fixed to an output shaft 12 of the prime mover 7 to be rotated together with the output shaft 12;

a blade holder 16 connected to the crank arm 15 via a link 17;

a chopper blade 3 held in the blade holder 16 and adapted to push the signature 1 from an upper surface thereof in order to insert the signature 1 into a space 11 between the pair of folding rollers 4; and

at least one guide unit 5 with at least a linear guide rail 19 connected to a linear slider 18 wherein the linear slider 18 is connected to the blade holder 16 for restricting motion of the blade holder 16 such that the blade holder 16 reciprocates only in a linear direction perpendicular to a conveyance plane along which the signature 1 is conveyed.

VI. ISSUES

Whether claim 1 is unpatentable under 35 U.S.C. §102(b) based on Kojima (U.S. Patent No. 5,085,625).

VII. GROUPING OF CLAIMS

There is no grouping of two or more claims. Claim 1 stands or falls by itself.

VIII. ARGUMENT

On the outset, it is the Applicants' understanding that in asserting a rejection, the Office is materially representing that 1) a best prior art reference has been applied; and 2) the merits of that reference supports a legal conclusion of unpatentability. It is against this understanding that the Applicants would like to challenge the Office rejection,

because the applied prior art of record simply does not teach or suggest the claimed invention on the merits. This shortcoming of the Office position will become apparent in view of the following explanations.

Rejection of claim 1 under 35 USC §102(b) over Kojima (USP 5,085,625)

In the Response to Arguments section at item 4 on page 3 of the final Office Action dated December 15, 2003, the Office provided the following reasons as to why the claimed invention is *anticipated* by Kojima:

Applicant's contends that Kojima or the German application No. 2247707 does not show or suggest a blade holder onto which is attached a linear slider. Examiner asserts that a reference anticipates a claimed invention when all the features are disclosed. In this instance case, in view of Kojima, *it would have been obvious to one having ordinary skills in the art* to have provide a blade holder at the vicinity of "13" supported via bearings "20a" and "20c" for the purpose of holding in position the chopper blade "8". Thereby, even that Fig. 6 does not specifically state that the chopper blade "8" is held by a blade holder wherein the blade holder is attached to the linear slider "6", it is deemed that a blade holder is holding in position the chopper blade "8", thereby providing a connection between the chopper blade "8" and the linear slider "6". For the reasons above, the grounds of rejections are deemed proper. (emphasis added).

From this quoted portion of the Office Action, it is apparent that the Office has erroneously asserted an obviousness standard (applicable under 35 U.S.C. §103) in an anticipation rejection under 35 U.S.C. §102. The §102 rejections are improper since the Office relied upon obviousness in order to make the rejection. Claimed features that are allegedly "*obvious*" cannot be said to be *anticipated* by the teachings of Kojima under 35 USC § 102. For at least this reason, the §102 rejection of claim 1 cannot stand.

Furthermore, the Office has essentially reduced the Applicant's contention to "Kojima or the German application No. 2247707 does not show or suggest a blade holder

onto which is attached a linear slider.” This is not the contention of the Applicant. The Applicant’s contention is that the asserted prior art fails to disclose or teach “a linear guide rail connected to a linear slider wherein the linear slider is connected to the blade holder”.

In rejecting the claimed invention, the final Office Action has specifically stated that “a guide unit via linear feeding crank mechanism “B1” for restricting motion of the blade holder such that the blade holder reciprocates only in a linear direction perpendicular to a conveyance plane.”

Regarding linear feeding crank mechanisms B1 and B2, Kojima in column 2 lines 32-36 has specifically stated that: “The linear feeding crank mechanism B1 is formed by the two spur gears 14a, 14b and the rotational axles 15a, 15b. The linear feeding crank mechanism B2 is formed by the two spur gears 14c, 14d and the rotational axles 15c, 15d.” These features are shown in Figures 2 and 4 of Kojima. From visual verification, it is clear that even though the end result is a linear feeding, the means of achieving this linear motion is through rotary motions of gears 14a, 14b, 14c, and 14d respectively about rotational axles 15a, 15b, 15c and 15d.

In contrast, the present invention as shown by way of an example in Figure 1, the guide unit 5 is formed of at least one linear guide rail 19 and a linear slider 18. These features are distinctly different from the gear and axle combinations of Kojima. As recited in claim 1:

“at least one guide unit with at least a linear guide rail connected to a linear slider wherein the linear slider is connected to the blade holder for restricting motion of the blade holder such that the blade holder reciprocates only in a linear direction perpendicular to a conveyance plane along which the signature is conveyed.”

It is well settled that:

"A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057 (Fed. Cir. 1988)."

For the foregoing reasons, independent claim 1 is not anticipated by Kojima under 35 U.S.C. §102.

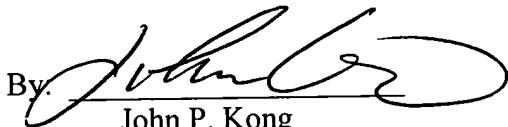
Moreover, even if the rejections were to be remade under the correct standards of 35 USC § 103, Kojima specifically *teaches away* from any modification of his invention using the "prior art" of Figure 6. Kojima states that the "prior art" of Figure 6 is a mechanism that is too large and that has reduced durability due to abraded sliding surfaces of the slider (*see e.g.*, column 1, lines 33 – 38). The invention of Kojima is directed to overcoming such deficiencies of the prior art of Figure 6. The linear feeding crank mechanisms B1 and B2 of Kojima rely on the spur gears 14a, 14b, 14c, 14d and the rotational axles 15a, 15b, 15c, 15d *instead of* the prior art structure of Figure 6. Basically, Kojima actually teaches away from the "obvious" modifications suggested in the final Office Action.

In accordance with the foregoing, it is submitted that the claimed invention patentably distinguishes over the applied prior art of record and the rejection of claim 1 under 35 USC §102 is erroneous. Therefore, reversal of the rejection of claim 1 is respectfully requested.

The Commissioner is hereby authorized to charge any underpayment of fees or credit any overpayment of fees in connection with this communication to Deposit Account 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

By: 

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Attachment: Submission of Appeal Brief w/Fee
Appendix

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IX. APPENDIX**CLAIMS ON APPEAL**

Claim 1 (previously presented): A chopper folder for a rotary press for folding signatures which are periodically conveyed, one signature at a time, from a folding machine, comprising:

a pair of folding rollers for folding a signature parallel to a conveyance direction of said signatures;

a prime mover;

a crank arm fixed to an output shaft of the prime mover to be rotated together with the output shaft;

a blade holder connected to the crank arm via a link;

a chopper blade held in the blade holder and adapted to push the signature from an upper surface thereof in order to insert the signature into a space between the pair of folding rollers; and

at least one guide unit with at least a linear guide rail connected to a linear slider wherein the linear slider is connected to the blade holder for restricting motion of the blade holder such that the blade holder reciprocates only in a linear direction perpendicular to a conveyance plane along which the signature is conveyed.

Claim 2 (allowed): A chopper folder for a rotary press for folding signatures which are periodically conveyed, one signature at a time, from a folding machine, comprising:

a pair of folding rollers for folding a signature parallel to a conveyance direction of said signatures;

a prime mover;

a crank arm fixed to an output shaft of the prime mover to be rotated together with the output shaft;

a blade holder connected to the crank arm via a link;

a chopper blade held in the blade holder and adapted to push the signature from an upper surface thereof in order to insert the signature into a space between the pair of folding rollers; and

at least one guide unit for restricting motion of the blade holder such that the blade holder reciprocates only in a direction perpendicular to a conveyance plane along which the signature is conveyed, wherein

the guide unit comprises sliders provided at opposite ends of the blade holder, and two guide rails arranged along the conveyance direction and adapted to guide the sliders;

the guide rails are supported such that a clearance greater than a thickness of the signature is provided between the guide rails and the conveyance plane, and each of the guide rails has a guide surface perpendicular to the conveyance plane; and

guided portions of the sliders are movable, while maintaining close contact with the guide surfaces of the guide rails at all times.